

## **REMARKS**

Please reconsider the present application in view of the above amendments and the following remarks. Applicant thanks the Examiner for carefully considering the present application.

### **I. Disposition of Claims**

Claims 1-5 and 7-19 are currently pending in the present application. Claims 1 and 17 have been amended. Additionally, new claims 20-38 have been added.

### **II. Claim Amendments**

Independent claim 1 has been amended to recite that the base film comprises a “mechanically dry rubbed surface.” No new matter has been added by way of this amendment as support for this amendment may be found, for example, in Figure 1 and on page 11, lines 8 – 12 of the present application.

Further, independent claim 1 has been amended to remove the term “adapted.” Independent claim 1 now recites, in part, “wherein, when the windable printing medium is wound into a roll, the printable face of a first wrap of the base film is in contact with the adhesive layer of a second wrap of the base film.” No new matter has been added by way of these amendments.

Dependent claim 17 has been amended to be dependent from independent claim 1. No new matter has been added by way of this amendment.

### **III. Rejection(s) Under 35 U.S.C § 112**

Claims 1 and 17 of the present application were rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter that the Applicant regards as the invention. For the reasons set forth below, reconsideration of this rejection is respectfully requested.

Specifically, the Examiner held the term “adapted” as rendering claim 1 indefinite. By way of this reply, the term “adapted” has been removed from claim 1.

Further, the Examiner asserted that claim 1 claims two separate embodiments: wound and unwound. Applicant notes that claim 1 recites the structure of a windable printing medium along with a feature of the windable printing medium that is present when the windable printing medium is wound, i.e., in rolled form. Thus, claim 1 is not claiming two separate embodiments. A printing medium that (1) has a base film and a printable face as recited in claim 1, and (2) when wound, has the characteristic that the printable face of a first wrap of the base film is in contact with the adhesive layer of a second wrap of the base film meets the requirements of claim 1. Therefore, the scope of claim 1 is not affected by whether the printing medium is actually in wound or unwound form. Instead, claim 1 is directed to a printing medium that, regardless of the printing medium’s actual wound/unwound state, is structured so as to possess particular properties were the printing medium in wound form.

With reference to claim 17, the Examiner pointed out that claim 17 of the present application fails to state the number of the claim from which it depends. By way of this reply, claim 17 has been amended to be dependent from claim 1.

Accordingly, withdrawal of the § 112 rejections of claims 1 and 17 of the present

application is respectfully requested.

#### IV. Rejection(s) Under 35 U.S.C § 103

##### Claims 1-3 and 5

Claims 1-3 and 5 of the present application were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 2,532,011 issued to Dahlquist et al. (hereinafter "Dahlquist") in view of Japanese Reference No. 07-330929 (hereinafter "Taku"). For the reasons set forth below, this rejection is respectfully traversed.

The present invention is directed to an improved printing medium. As recited in amended independent claim 1 of the present application, the present invention requires a windable printing medium that comprises (1) a base film (e.g., 11 in Figures 1, 2a, 2b, 3-5, and 7a-7c of the present application) comprising a mechanically dry rubbed surface (formed by rubbing means 7 shown in Figure 1 of the present application) and an adhesive layer (e.g., 13 in Figures 2b and 3 of the present application) disposed on the rubbed surface and (2) a printable face (e.g., 16 in Figures 7b and 7c of the present application) formed on a surface of the base film opposite the rubbed surface, where, when the windable printing medium is wound into a roll (as represented in Figure 7a of the present application), the printable face of a first wrap of the base film is in contact with the adhesive layer of a second wrap of the base film.

The claimed feature of a base film comprising a mechanically dry rubbed surface in amended independent claim 1 is shown in Figure 1 of the present application. In Figure 1, a surface of base film 11 is passed over a rubbing means 7. The rubbing means 7 causes the formation of a rubbed surface of the base film 11, where the rubbed surface

allows for a greater adhesion between the base film **11** and an adhesive layer such that the base film and adhesive layer do not separate when the printing medium is handled. Further, as described in the present application, the rubbing means **7** rubs a surface of the base film **11** in a dry atmosphere and may be formed, for example, of any one of cotton cloth, carbon fiber, nylon, and rayon. *See* Specification, page 8, lines 28 – 21; page 11, lines 8 – 12. Thus, the base film **11** is said to comprise a “mechanically dry rubbed surface” in amended independent claim 1.

With respect to Dahlquist, in paragraph 5 of the Office Action of April 28, 2003, the Examiner explicitly states that Dahlquist fails to teach the use of a base film that has a surface that been rubbed to improve adhesion. However, the Examiner asserts that Taku discloses such a limitation.

Taku, which is directed to a technique for treating a surface of a synthetic resin film, discloses a non-dry rubbing treatment in which a fabric (or like) infiltrated, i.e., soaked, with a coupling agent is applied to the surface of the synthetic resin. *See* Taku, paragraphs [0009] – [0011]. Thus, Taku fails to disclose a “mechanically dry rubbed surface” as required by amended independent claim 1 of the present application. It is further apparent that Taku does not teach, and actually teaches away from, the use of a “mechanically dry rubbed surface” because Taku specifically discloses an altogether separate drying stage for drying the rubbed portions of the synthetic resin film. *See, e.g.,* Taku, paragraphs [0011] – [0012].

In view of the above, Dahlquist and Taku, whether considered separately or in combination, fail to show or suggest the present invention as recited in amended independent claim 1 of the present application. Thus, amended independent claim 1 of

the present application is patentable over Dahlquist and Taku. Dependent claims 2, 3, and 5 of the present application are allowable for at least the same reasons. Accordingly, withdrawal of the rejection based on Dahlquist and Taku is respectfully requested.

Claims 7-10, 12, 13, and 18

Claims 7-10, 12, 13, and 18 of the present application were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dahlquist in view of Taku, and further in view of U.S. Patent No. 5,663,288 issued to Shinoda et al. (hereinafter "Shinoda") and Japanese Reference No. 08-267968 (hereinafter "Kanshin"). For the reasons set forth below, this rejection is respectfully traversed.

As discussed above, Dahlquist and Taku fail to disclose the limitation of a base film comprising a mechanically dry rubbed surface as required by amended independent claim 1 of the present application. Both Shinoda and Kanshin also fail to disclose, or otherwise teach, this limitation.

Shinoda, which is directed to a degradable printing medium, discloses a degradable adhesive film that uses a substrate film that can be degraded and disappeared in the environment after use. Shinoda, column 2, lines 65 – 67. Shinoda is completely silent as to a rubbing treatment of a film.

Similarly, Kanshin, which is directed to a biodegradable card (e.g., a biodegradable credit card), is also completely silent as to a rubbing treatment of a film. Moreover, there can be no motivation to combine Kanshin with Dahlquist and Taku because Kanshin is directed to non-analogous art. In any event, both Shinoda and Kanshin fail to disclose those limitations of amended independent claim 1 of the present

application not disclosed or taught by Dahlquist and Taku.

In view of the above, Dahlquist, Taku, Shinoda, Kanshin, whether considered separately or in any combination, fail to show or suggest the present invention as recited in amended independent claim 1 of the present application. Thus, amended independent claim 1 of the present application is patentable over Dahlquist, Taku, Shinoda, and Kanshin. Dependent claims 7-10, 12, 13, and 18 of the present application are allowable for at least the same reasons. Accordingly, withdrawal of the rejection based on Dahlquist, Taku, Shinoda, and Kanshin is respectfully requested.

Claim 4

Claim 4 of the present application was rejected under 35 U.S.C. § 103(a) as being unpatentable over Dahlquist in view of Taku, and further in view of U.S. Patent No. 5,563,023 issued to Kangas et al. (hereinafter "Kangas") and Japanese Reference No. 411322949 (hereinafter "Natsume"). For the reasons set forth below, this rejection is respectfully traversed.

As discussed above, Dahlquist and Taku fail to disclose the limitation of a base film comprising a mechanically dry rubbed surface as required by amended independent claim 1 of the present application. Both Kangas and Natsume also fail to disclose, or otherwise teach, this limitation.

Kangas, which is directed to photoimageable elements, discloses protective coatings for photosensitive imaging layers on photoimageable elements. Kangas, column 2, lines 18 – 25. Kangas is completely silent as to a rubbing treatment of a film. Moreover, there can be no motivation to combine Kangas with Dahlquist and Taku

because Kangas is directed to non-analogous art.

Similarly, Natsume, which is directed to colorant composition that is capable of coloring an aliphatic polyester-based biodegradable resin simultaneously with a molding of the resin, is also completely silent as to a rubbing treatment of a film. Moreover, there can be no motivation to combine either Kangas or Natsume with Dahlquist and Taku because Kangas and Natsume are directed to non-analogous art. In any event, both Kangas and Natsume fail to disclose those limitations of amended independent claim 1 of the present application not disclosed or taught by Dahlquist and Taku.

In view of the above, Dahlquist, Taku, Kangas, and Natsume, whether considered separately or in any combination, fail to show or suggest the present invention as recited in amended independent claim 1 of the present application. Thus, amended independent claim 1 of the present application is patentable over Dahlquist, Taku, Kangas, and Natsume. Dependent claim 4 of the present application is allowable for at least the same reasons. Accordingly, withdrawal of the rejection based on Dahlquist, Taku, Kangas, and Natsume is respectfully requested.

Claims 7, 8, and 11

Claims 7, 8, and 11 of the present application were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dahlquist in view of Taku, and further in view of U.S. Patent No. 6,235,825 issued to Yoshida et al. (hereinafter "Yoshida"). For the reasons set forth below, this rejection is respectfully traversed.

As discussed above, Dahlquist and Taku fail to disclose the limitation of a base film comprising a mechanically dry rubbed surface as required by amended independent

claim 1 of the present application. Yoshida also fails to disclose, or otherwise teach, this limitation.

Yoshida, which is directed to a polylactic acid-based resin composition, discloses obtaining such a composition by mixing polylactic acid-based resin with specific flexible aliphatic polyester and blending the resultant mixture with a biodegradable plasticizer having good compatibility with the resultant mixture. Yoshida, column 2, lines 31 – 38. Yoshida is completely silent as to a rubbing treatment of a film. Moreover, there can be no motivation to combine Yoshida with Dahlquist and Taku because Yoshida is directed to non-analogous art. In any event, Yoshida fails to disclose those limitations of amended independent claim 1 of the present application not disclosed or taught by Dahlquist and Taku.

In view of the above, Dahlquist, Taku, and Yoshida, whether considered separately or in any combination, fail to show or suggest the present invention as recited in amended independent claim 1 of the present application. Thus, amended independent claim 1 of the present application is patentable over Dahlquist, Taku, and Yoshida. Dependent claims 7, 8, and 11 of the present application are allowable for at least the same reasons. Accordingly, withdrawal of the rejection based on Dahlquist, Taku, and Yoshida is respectfully requested.

Claims 14-16

Claims 14-16 of the present application were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dahlquist in view of Taku and Shinoda, and further in view of U.S. Patent No. 6,162,858 issued to Auguste et al. (hereinafter “Auguste”). For the



reasons set forth below, this rejection is respectfully traversed.

As discussed above, Dahlquist, Taku, and Shinoda fail to disclose the limitation of a base film comprising a mechanically dry rubbed surface as required by amended independent claim 1 of the present application. Auguste also fails to disclose, or otherwise teach, this limitation.

Auguste, which is directed to a printable adhesive composite, discloses a composite formed of a microporous printing-writing medium based on a high molecular weight polyolefin and a plasticizer-free pressure-sensitive adhesive. Auguste, column 3, lines 38 – 46. Auguste is completely silent as to a rubbing treatment of a film. Moreover, there can be no motivation to combine Auguste with Dahlquist and Taku because Auguste is directed to non-analogous art. In any event, Auguste fails to disclose those limitations of amended independent claim 1 of the present application not disclosed or taught by Dahlquist, Taku, and Shinoda.

In view of the above, Dahlquist, Taku, Shinoda, and Auguste, whether considered separately or in any combination, fail to show or suggest the present invention as recited in amended independent claim 1 of the present application. Thus, amended independent claim 1 of the present application is patentable over Dahlquist, Taku, Shinoda, and Auguste. Dependent claims 14-16 of the present application are allowable for at least the same reasons. Accordingly, withdrawal of the rejection based on Dahlquist, Taku, Shonida, and Auguste is respectfully requested.

Claims 17 and 19

Claims 17 and 19 of the present application were rejected under 35 U.S.C. §

103(a) as being unpatentable over Dahlquist in view of Taku and Shinoda, and further in view of U.S. Patent No. 6,162,858 issued to Ashida (hereinafter "Ashida"). For the reasons set forth below, this rejection is respectfully traversed.

As discussed above, Dahlquist, Taku, and Shinoda fail to disclose the limitation of a base film comprising a mechanically dry rubbed surface as required by amended independent claim 1 of the present application. Ashida also fails to disclose, or otherwise teach, this limitation.

Ashida, which is directed to an ink jet recording medium, discloses a medium having a support and a layer of fine particles of a thermoplastic organic polymer, formed on the support, where the fine particles of the thermoplastic organic polymer have an average particle size within a range of from 1 to 20  $\mu\text{m}$ . Ashida, column 4, lines 9 – 22. Ashida is completely silent as to a rubbing treatment of a film. Moreover, there can be no motivation to combine Ashida with Dahlquist and Taku because Ashida is directed to non-analogous art. In any event, Ashida fails to disclose those limitations of amended independent claim 1 of the present application not disclosed or taught by Dahlquist, Taku, and Shinoda.

In view of the above, Dahlquist, Taku, Shinoda, and Ashida, whether considered separately or in any combination, fail to show or suggest the present invention as recited in amended independent claim 1 of the present application. Thus, amended independent claim 1 of the present application is patentable over Dahlquist, Taku, Shinoda, and Ashida. Dependent claims 17 and 19 of the present application are allowable for at least the same reasons. Accordingly, withdrawal of the rejection based on Dahlquist, Taku, Shonida, and Ashida is respectfully requested.

**V. New Claims**

New claims 20-38 have been added. New dependent claim 20 depends from amended independent claim 1 and recites that the mechanically dry rubbed surface of amended independent claim 1 “is formed with any one of a cotton cloth, carbon fiber, nylon, and rayon.” No new matter has been added by way of new claim 20 as support for new claim 20 may be found, for example, on page 11, lines 8 – 12 of the present application. Further, because amended independent claim 1 has been shown above to be patentable over the prior art, new claim 20 is allowable for at least the same reasons.

New independent claim 21 contains all the limitations of amended independent claim 1 and further includes the limitation that the “rubbed surface of the base film is produced by rubbing surface of the base film with at least one of a cotton cloth and a nylon brush.” No new matter has been added by way of new claim 21 as support for new claim 20 may be found, for example, in original claim 1 and on page 11, lines 8 – 12 of the present application. New claims 22-38 depend from new independent claim 21.

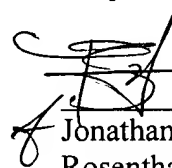
Accordingly, entry and favorable treatment of new claims 20-38 is respectfully requested.

**VI. Conclusion**

Applicant believes this reply to be fully responsive to all outstanding issues and place this application in condition for allowance. If this belief is incorrect, or other issues arise, do not hesitate to contact the undersigned or his associates at the telephone number listed below. Because the amendments simplify the issues for allowance or appeal, and do not constitute new matter, entry thereof is respectfully requested. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 03310.002001; 00-3085).

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Respectfully submitted,

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